

REMARKS

This Amendment is submitted simultaneously with filing a Request for Continuing Examination.

In the last Office Action Claims 1-3 and 5 have been rejected under 35 USC 102(b) over the patent to Godfrey.

Claim 6 is rejected under 35 USC 102(b) or 103(a) over the patent to Godfrey.

Claim 18 is rejected under 35 USC 102(b) over the patent to Godfrey in view of the patent to Odendahl.

Claim 22 is rejected under 35 USC 103 over the patent to Godfrey.

At the same time, Claims 16, 17 and 23 were not rejected over the art.

In connection with the Examiner's indication of the allowability of some claims, Claims 16 and 23 have been rewritten in independent form, and it is believed that these claims are now in allowable condition.

After carefully considering the Examiners grounds for rejection of the claims over the art, applicants cancelled Claim 1 and submitted new Claim 24, the broadest claim on file.

The retained dependent claims have been amended to depend on the new Claim 24.

It is respectfully submitted that the new features of the present invention which are now defined in Claim 24 are not disclosed in the prior art applied by the Examiner.

Claim 24 specifically defines a hand-held power saw in which, in addition to the lifting rod, the saw blade connected with the lifting rod and movable in an oscillating motion, the coupling means for retaining and driving the saw blade and connecting the saw blade to the lifting rod, and the guide assembly for guiding the oscillating motion of the saw blade, the guide assembly includes at least one lateral bracing means for shielding the coupling means from shear forces acting on the saw blade.

The bracing means in accordance with the present invention is located in the region of the coupling means and directly guide the saw blade during its oscillating motion.

The Godfrey reference applied by the Examiner against the original claims does not disclose these new features of the present invention.

In particular, the bracing means in the Godfrey reference are located behind the coupling means. The bracing means in this reference guide the lifting rod. Thus, the bracing means in the Godfrey reference is not located in the region of the coupling means as defined in Claim 24, and the bracing means in the Godfrey reference does not directly guide the saw blade during its oscillating motion.

It is therefore respectfully submitted that the new features of the present invention which are now defined in Claim 24 are not disclosed in this reference and could not be derived from it as a matter of obviousness.

As for the anticipation rejection of original claims over this reference, it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Godfrey, as emphasized hereinabove, does not disclose each and every element of the present invention as now defined in Claim 24.

Therefore, the anticipation rejection should be considered as no longer tenable and should be withdrawn.

The patent to Godfrey as well as other references do not provide any hint, suggestion, or motivation for the new features of the present invention as now defined in Claim 24. In order to arrive at the present invention from the teachings of the references, the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in Claim 24 and were first proposed by applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above, it is believed that Claim 24 cannot be considered as obvious from the teaching of the patent to Godfrey taken singly or in combination with other references.

Claim 24 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 24, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'M. Striker', with a long horizontal flourish extending to the right.

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